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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 10/16/2007

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notification of Non-Compliant Appeal Brief
(37 CFR 41.37)**

Application No.

09/884,487

Applicant(s)

PARK, JIN-HO

Examiner

Jeff Piziali

Art Unit

2629

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 02 July 2007 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.

EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☒ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☒ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

See Continuation Sheet.



Jeff Piziali
10 October 2007

Continuation of 10. Other (including any explanation in support of the above items):

First and foremost, the appellant is thanked for the "Amended Brief on Appeal Pursuant to 37 C.F.R. 41.37" filed 2 July 2007. However, a seemingly non-compliant issue has been discovered in the aforementioned response, requiring attention before examination may continue.

37 CFR 41.37(c)(1)(iv) requires the "Status of amendments" section of the brief must contain, "A statement of the status of any amendment filed subsequent to final rejection."

The "Status of amendments" section of the brief is designed to avoid confusion as to which claims are on appeal, and the precise wording of those claims, particularly where the appellant has sought to amend claims after final rejection. The inclusion of the "Status of amendments" section in the brief should advise the examiner of what the appellant considers the status of the claims and post-final rejection amendments to be, allowing any disagreement on these questions to be resolved before the appeal is taken up for decision by the Board.

The currently pending "Status of amendments" section of the brief (see page 3) inaccurately states, "All amendments have been entered." In actuality, no amendments have been filed (nor entered) subsequent to final rejection (mailed 12 November 2002). The appellant is respectfully encouraged to provide a corrected statement of the status of any amendment filed subsequent to final rejection, i.e., whether or not the amendment has been acted upon by the examiner, and if so, whether it was entered, or denied entry.

37 CFR 41.37(c)(1)(v) requires the "Summary of claimed subject matter" section of the brief must contain, "A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters."

The currently pending "Summary of claimed subject matter" section of the brief (see page 3) neglects to completely map the argued subject matter of claim 17 to the instant specification and drawings.

Appealed claim 17 recites the subject matter of, "an input voltage port that is connected to the primary coil to provide a DC input voltage to the primary coil." However, the "Summary of claimed subject matter" section pertaining to claim 17 instead links the subject matter of, "an input port (Vin) is connected to the primary coil (T61) to provide a DC output voltage (VDD)." No explicit specification mapping of the claimed and argued (see pages 8-9) "DC input voltage" has been provided for this claim. The appellant is respectfully encouraged to map all separately argued subject matter to the respective claims and portions of the specification and drawings.

Additionally, the examiner notes that the "Summary of claimed subject matter" section of the brief repeatedly refers to published application paragraph numbers. The appellant is respectfully encouraged to refer to the original specification by page and line number only, and to the drawing, if any, by reference characters.

Additionally, 37 CFR 41.37(c)(1)(vi) requires the "Grounds of rejection to be reviewed on appeal" section of the brief must contain, "A concise statement of each ground of rejection presented for review."

MPEP 1205 further explains, "A concise statement of each ground of rejection presented for review. For example, the statement 'Whether claims 1 and 2 are unpatentable' would not comply with the rule, while the statements 'Whether claims 1 and 2 are unpatentable under 35 U.S.C. 103 over Smith in view of Jones,' and 'Whether claims 1 and 2 are unpatentable under 35 U.S.C. 112, first paragraph, as being based on a nonenabling disclosure' would comply with the rule. The statement cannot include any argument concerning the merits of the ground of rejection presented for review. Arguments should be included in the 'Argument' section of the brief."

The currently pending "Grounds of rejection to be reviewed on appeal" section of the brief (see page 5) improperly provides arguments concerning the merits of the ground of rejection pertaining to claims 10, 11, 17, and 18. The appellant is respectfully encouraged to remove any arguments concerning the merits of the ground of rejection from the "Grounds of rejection to be reviewed on appeal" section of the brief. A discussion of particular prior art subject matter teachings is instead suited for the "Argument" section of the brief.

At least for such reasoning, the pending "Amended Brief on Appeal Pursuant to 37 C.F.R. 41.37" filed 2 July 2007 is deemed non-compliant.

Please note: The appeal brief has not been checked to the extent necessary to determine the presence of all possible non-compliance errors. If additional issues of non-compliance are discovered in a subsequent response, yet another Notification of Non-Compliant Appeal Brief will be necessitated. Appellant's cooperation is requested in correcting any other errors of which appellant may become aware in the brief.

Jeff Piziali
10 October 2007.

